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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/665,960

09/18/2003

Xiaoru Wang

82215ASMR

8319

7590 04/05/2007
Paul A. Leipold
Patent Legal Staff
Eastman Kodak Company
343 State Street
Rochester, NY 14650-2201

EXAMINER

SHOSHO, CALLIE E

ART UNIT

PAPER NUMBER

1714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/05/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/665,960

Applicant(s)

WANG ET AL.

Examiner

Callie E. Shosho

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7 and 9-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7 and 9-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. All outstanding rejections except for those described below are overcome by applicants' amendment filed 1/8/07.

It is noted that in the 35 USC 112, first paragraph rejection of record set forth in paragraph 4 of the office action mailed 9/8/06, the examiner argue that there was no support to recite "wherein essentially no monomer is present in the aqueous mixture" and no support to recite "essentially". In light of applicants' arguments and upon reconsideration, it is noted that the 35 USC 112, first paragraph rejection with respect to the first cited phrase has been withdrawn, however, the latter rejection of the second cited phrase remains. Thus, the 35 USC 112, first paragraph rejection of record has been re-written below to reflect this change but does not set forth any new grounds of rejection.

The new grounds of rejection set forth below with respect to newly added claims 11-12 are necessitated by applicants' amendment and thus, the following action is final.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 3-7, and 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the

Art Unit: 1714

relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recites, “wherein essentially no monomer is present in the aqueous pigment mixture”.

Specifically, with respect to the recitation of the phrase “essentially”, it is the examiner’s position that this phrase fails to satisfy the written description requirement under the cited statute since there does not appear to be a written description requirement of the phrase in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163. Applicant has not pointed to any portion of the specification, and examiner has not found any support for this phraseology in the specification as originally filed.

It is noted that in the amendment filed 1/26/06, applicants amended claim 1 to recite “wherein no monomer is present in the aqueous pigment mixture”. Subsequently, in the amendment filed 6/5/06, applicants inserted the phrase “essentially” into claim 1, i.e. “wherein essentially no monomer is present in the aqueous pigment mixture”. However, it is the examiner’s position there is no support in the specification as originally filed to recite “essentially” no monomer.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1714

5. Claims 1, 3-7, and 9-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The rejection is adequately set forth in paragraph 6 of the office action mailed 9/8/06 and is incorporated here by reference.

Claim Rejections - 35 USC § 102

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 10 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Lin (U.S. 5,281,261).

The rejection is adequately set forth in paragraph 8 of the office action mailed 9/8/06 and is incorporated here by reference.

With respect to newly added claim 12, it is further noted that Example VI of Lin discloses adding initiator solution to pigment dispersion, i.e. water, pigment, dispersant, namely, sodium p-styrene sulfonate salt wetting agent, which mixture is then added to monomer mixture, i.e. monomer and initiator. Therefore, there is disclosed sequential addition of initiator to pigment prior to adding monomer mixture. Further, Lin discloses that the free radical initiator reacts with the pigment to form a pigment radical which then polymerizes the monomer (col.9, lines 57-65).

Response to Arguments regarding 35 USC 112 rejections

8. Applicants' argue that the phrase "essentially" no monomer is clear and is made to prevent a potential infringer from adding, for example, a single monomer to the claimed mixture to design around the claims.

However, firstly, the examiner's position remains that there is no support in the specification as originally filed to recite "essentially". Applicant has not pointed to any portion of the specification, and examiner has not found any support for this phraseology in the specification as originally filed. There is no disclosure of the phrase "essentially" in the specification as originally filed.

Further, the examiner's position remains that the scope of the claims reciting "essentially" remains confusing given that it is not clear what is meant by the phrase. Further, it is not clear what, if any, difference there is between the phrase "essentially" no monomer and "no monomer". Clarification is requested.

Response to Arguments regarding 35 USC 102 rejection

9. Previously, the examiner noted that the present claims recite "consisting essentially of" transitional language with respect to the aqueous colorant mixture, i.e. "consisting essentially of colorant particles, dispersant or surfactants, and water". While Lin discloses that the aqueous colorant mixture contains monomer, it was noted that while it is recognized that the phrase "consisting essentially of" narrows the scope of the claims to the specified materials and those which do not materially affect the basic and novel characteristics of the claimed invention, absent a clear indication of what the basic and novel characteristics are, "consisting essentially

Art Unit: 1714

of” is construed as equivalent to “comprising”. Further, the burden is on the applicant to show that the additional ingredients in the prior art, i.e. monomer, would in fact be excluded from the claims and that such ingredients would materially change the characteristics of the applicant’s invention, See MPEP 2111.03. The examiner also noted that in example VIB of Lin, for instance, it is disclosed that in the aqueous colorant mixture the monomer is utilized as a wetting agent to disperse pigment, i.e. functions as a dispersant, and thus, the monomer in the aqueous colorant phase of Lin would fall within the scope of the present claims, i.e. aqueous colorant mixture of Lin contains only water, pigment, and dispersant (monomer).

Applicants argue that the basic and novel characteristics clearly relate to the absence of monomer from the pigment mixture prior to addition of initiator resulting in the basic and novel characteristic of stability and point to the summary of the invention and field of invention sections in the present specification.

However, while these portions of the specification disclose that the composite colorant particles of the present invention have better stability than those prepared in the prior art and are very stable, applicants have provided no evidence to support this position, i.e. evidence showing that that the additional ingredient the prior art, namely, monomer, would in fact be excluded from the claims and that such ingredient would materially change the characteristics of applicants’ invention.

Applicants also argue that the composite polymer particles of Lin would not form stable dispersion as defined by the particles not flocculating for up to 20 minutes when a dispersion containing the particles is added to acetone at a 1wt.% concentration as required in present claim10.

However, while there is no explicit disclosure in Lin that the composite colorant polymer particles are stable, i.e. do not flocculate for up to 20 minutes when a dispersion containing the particles is added to acetone at 1% by weight concentration as presently claimed, given that Lin discloses composite colorant polymer particles identical to that presently claimed, it is clear, absent evidence to the contrary, that the composite colorant polymer particles would inherently possess same stability as presently claimed.

It is noted that applicants' 1.132 declaration remains unpersuasive for the reasons set forth in paragraph 9 of the office action mailed 9/8/06.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 1714

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
4/1/07